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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,326	03/02/2004	James J. Wang	22770	1809
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K.F. ROSS P.C. 5683 RIVERDALE AVENUE SUITE 203 BOX 900 BRONX, NY 10471-0900				
EXAMINER				
HELM, CARALYNNE E				
ART UNIT		PAPER NUMBER		
1615				
MAIL DATE		DELIVERY MODE		
10/01/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

10/791,326

## Applicant(s)

WANG ET AL.

## Examiner

CARALYNNE HELM

## Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 25 and 27-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25 and 27-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments, filed June 20, 2008, have been fully considered and are persuasive in part. However, it is respectfully noted that Applicant argues intended uses and limitations that are not recited in the claims. In response to the arguments that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., cosmetic use, imparting of smoother skin feel, etc.) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject

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matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

The four factual inquiries of *Graham v. John Deere Co.* have been fully analyzed and considered in the rejections that follow.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 25 and 27-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Finberg (EP0315836) in view of Halloran et al. (US Patent No. 5,173,290), Lamaze et al. (US Patent No. 7,256,232), and Sanders et al. (US Patent No. 6,706,405)

Finberg teaches a particle composition composed of an interpenetrating network of at least two polymers that are not crosslinked to each other (see page 2 lines 5-7; instant claim 25). Further Finberg teaches that the composition can be formed via suspension, yielding small (spherical) particles, or formed into beads (see page 3 lines 11-14; instant claim 25). The invention is taught to include polydimethylsiloxane as one polymer and the second polymer is not limited to any particular polymer (see page 4 lines 17-20 and 28-29; instant claim 25). Finberg does on to teach the proportion of the polydimethylsiloxane to the other polymer in the system to be approximately 1:1 (see table 1; instant claim 28). Although a particular particle dimension is not specifically taught by Finberg, one of ordinary skill in the art would have found it obvious to optimize this parameter as a matter of routine experimentation in order to address the end-use needs of the product. Finberg does not teach polymethylsilsesquioxane specifically as the second polymer.

Halloran et al. teach that interpenetrating polymer networks provide a mechanism in addition to physical blending a copolymerization, to physically combine different polymers (see column 8 lines 30-38). They go on to teach that unique properties can result when these types of blends are produced (see column 8 lines 38-49). Further, in their invention Halloran et al. teach the presence of a silsesquioxane polymer in an interpenetrating network (see column 4 lines 11-25; instant claim 25). Sanders et al.

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also teach an interpenetrating polymer network that includes both a silsesquioxane, where polymethylsilsesquioxane is envisioned, and a linear siloxane where polydimethylsiloxane is envisioned (see column 4 lines 14-18, column 5 lines 1-16 and lines 55-59; instant claim 25). In addition, Lamaze et al. teach a composition where polymethylsilsesquioxane and polydimethylsiloxane are specifically taught as a desired combination. Since it was known to blend these two siloxane polymers, each was known to be able to be included in an interpenetrating network, and the production of such a network was a known option for blending the two, it would have been obvious to one of ordinary skill in the art at the time the invention was made to select polymethylsilsesquioxane as the second polymer to include with polydimethylsiloxane in the particle taught by Finberg.

Instant claims 27 and 29-34 are product-by-process claims that add no structural limitations to the claimed product. According to MPEP 2113, "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.' In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)." Therefore the limitations of these claims are automatically met when the limitations of the actual product are met (e.g. instant claim 25). Therefore claims 25 and 27-34 are obvious over Finberg in view of Halloran et al., Lamaze et al., and Sanders et al.

***Conclusion***

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CARALYNNE HELM whose telephone number is (571)270-3506. The examiner can normally be reached on Monday through Thursday 8-5 (EDT).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Caralynne Helm/  
Examiner, Art Unit 1615

/MP WOODWARD/  
Supervisory Patent Examiner, Art Unit 1615